

Appl. No. 10/279,647
 Amdt. Dated May 24, 2004
 Reply to Office action of February 26, 2004

REMARKS/ARGUMENTS

Applicant's attorney acknowledges the Examiner's kind assistance in understanding the rejections in the outstanding Office Action and has presented herewith, to the best of his understanding, a complete and responsive amendment. If for any reason Applicant's attorney has inadvertently misconstrued the Examiner's intent in this regard, additional direction from the Examiner is earnestly requested.

Specification

Without providing any specific guidance for correction, the Examiner made reference to the standards for the proper language and format for an Abstract of the Disclosure. Applicants submit herewith an amended Abstract of the Disclosure that is more closely tailored to the standards for the proper language and format for an Abstract of the Disclosure. If additional correction is desired, Applicants respectfully request that the Examiner provide a more detailed request for correction.

Claim Rejections - 35 USC §112

The Examiner rejected claims 2, 3, and 17 due to lack of sufficient antecedent basis for certain limitations in the referenced claims. Applicants have amended the rejected claims herewith to more particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

As to claim 2, the phrase "document number" has been replaced with "identifier."

As to claim 3, the phrase "document number" has been replaced with "identifier."

As to claim 17, the word "the" has been replaced with "a."

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Given that no other grounds for rejection of the instant claims was provided by the Examiner, Applicants respectfully submit that claims 2, 3, and 17, as presently amended, are now in condition for allowance.

Claim Rejections - 35 U.S.C. §102(a)

Although claims 1, 4, 5, 6, 7, 8, and 9 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Lundberg (U.S. Patent Publication 20040107153 A1), the Examiner indicated in a telephone conversation with Applicants' attorney that the Examiner was revising the grounds for rejection to reflect a rejection based on 35 U.S.C. §102(a) instead of 35 U.S.C. §102(e). Based on this conversation with the Examiner, Applicants respond as follows.

The following is a quotation of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent

For a prior art reference to be available to form the basis for a rejection under 35 U.S.C. §102(a), the invention must be “patented or described in a printed publication in this or a foreign country, *before* the invention thereof by the applicant for patent.” (emphasis added).

Based on the concept of “constructive reduction to practice,” 37 C.F.R. 1.131, Applicants are entitled to a date of invention at least as early as October 23, 2000, which is the filing date of Applicants' patent application. Given that the Lundberg reference cited by the examiner is not an issued patent and that the Lundberg reference has a publication date of Jun, 3, 2004,

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Applicants respectfully submit that Lundberg was not published prior to invention by the Applicants. Accordingly, Applicants respectfully submit that Lundberg is unavailable as a prior art reference and that any rejection based on Lundberg as a prior art reference is inappropriate and should be withdrawn.

Additionally, in order to substantiate a rejection based on the invention being "known or used by others in this country," Some type of evidence to substantiate the rejection must be supplied or, in the alternative, the Examiner must have some personal knowledge of the invention being "known or used by others." (MPEP 706.02(c)). In the outstanding Office Action, the Examiner has not provided any evidence to substantiate a rejection based on the fact that "the invention was known or used by others in this country" prior to Applicants' invention.

Given that the Examiner has not provided any valid prior art reference or other evidence to substantiate a rejection based on 35 U.S.C. §102(a), Applicants respectfully request reconsideration by the Examiner and withdrawal of the rejection based on 35 U.S.C. §102(a). Applicants further submit that claims 1, 4, 5, 6, 7, 8, and 9, as originally filed, are in condition for allowance. Such allowance is respectfully requested at the earliest possible date.

Claim Rejections - 35 U.S.C. §102(e)

Claim 22, 23, 24, 25, 26, and 27 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Johnson et al. (U.S. Patent 6,603,569). Applicants note that the reference cited by the Examiner (U.S. Patent 6,603,569) is not the same reference that was included in the outstanding Office Action. Instead, the reference included by the Examiner in the outstanding Office Action was Johnson et al. (U.S. Patent 5,282,052). Applicants' attorney has examined Johnson et al. (U.S. Patent 6,603,569) and finds it wholly inapplicable to Applicants' invention. Accordingly, Applicants have addressed the Examiner's rejection in light of Johnson et al. (U.S.

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Patent 5,282,052) inasmuch as the language used by the Examiner in the outstanding Office Action tracks the text of Johnson et al. (U.S. Patent 5,282,052). If this is inappropriate, Applicants respectfully request that the Examiner clarify the issues as to the Johnson et al. (U.S. Patent 6,603,569) reference.

In order to substantiate rejection of a claim under 35 U.S.C. §102(e), the cited reference must teach "each and every element as set forth in the claim" (MPEP 2131).

Johnson et al. (U.S. Patent 5,282,052) apparently teach techniques for automatic form creation by combining partial operations.

In contrast, Applicants' invention, as claimed in amended independent claim 22, is a dynamically created fax cover sheet comprising at least one dynamic content zone, wherein said at least one dynamic content zone contains a globally unique identifier which was generated by a digital filing application; and a digital image of said dynamically-generated fax cover sheet, said globally unique identifier linking said digital image of said dynamically-generated fax cover sheet to a record in a database, said record having been created prior to the creation of said digital image of said dynamically-generated fax cover.

Johnson et al. (U.S. Patent 5,282,052) do not teach, describe, or suggest the use of a globally unique identifier to link a digital image of a fax cover sheet to a previously created record in a database as specifically set forth in amended independent claim 22. Accordingly, Johnson et al. (U.S. Patent 5,282,052) fail to teach each and every element as set forth in claim 22 and Applicants respectfully submit that amended independent claim 22 is in condition for allowance. Such allowance is respectfully requested at the earliest possible date.

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Claim Rejections - 35 U.S.C. §103

Claim 10-16 were rejected by the Examiner under 35 U.S.C. §103 as being unpatentable over Lundberg (U.S. Patent Publication 20040107153 A1), in view of Johnson et al. (U.S. Patent 6,603,569).

As previously explained, based on the concept of "constructive reduction to practice," 37 C.F.R. 1.131, Applicants are entitled to a date of invention at least as early as October 23, 2000, which is the filing date of Applicants' patent application. Given that the Lundberg reference cited by the examiner is not an issued patent and that the Lundberg reference has a publication date of Jun, 3, 2004, Applicants respectfully submit that Lundberg was not published prior to invention by the Applicants. Accordingly, Applicants respectfully submit that Lundberg is unavailable as a prior art reference and that any rejection based on Lundberg as a prior art reference is inappropriate and should be withdrawn.

Therefore, Applicants respectfully submit that any rejection based on the combination of Lundberg and Johnson is inappropriate and should be withdrawn.

Given that the Examiner has not provided any valid prior art reference or other evidence to substantiate a rejection based on 35 U.S.C. §103, Applicants respectfully request reconsideration by the Examiner and withdrawal of the rejection based on 35 U.S.C. §103. Applicants further submit that claims 10-16, as originally filed, are in condition for allowance. Such allowance is respectfully requested at the earliest possible date.

Conclusion


In summary, none of the cited art, either alone or in combination, discloses, teaches, or suggests the unique combination of features in Applicants' claims presently on file. Therefore,

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Applicants respectfully assert that all of Applicants' claims, as presently amended or previously constituted, are allowable over the art of record. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case at the earliest possible date. Applicants represent hereby that no new matter has been added as a result of this amendment. The Examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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